

REMARKS

This responds to the Office Action mailed on April 21, 2009.

Claims 1-5 are amended, claims 7-15 are canceled, and no claims are added; as a result, claims 1-6 are now pending in this application.

§ 102 Rejection of the Claims

Claims 7-15 were rejected under 35 U.S.C. § 102(b) as being anticipated by Lupulescu et al. (U.S. Publication No. 2003/0030751; hereinafter "Lupulescu"). Applicant has canceled claims 7-15 obviating these rejections.

§ 103 Rejection of the Claims

Claims 1-6 were rejected under 35 U.S.C. § 103(a) as being obvious over Novak et al. (U.S. Publication No. 2003/0097655; hereinafter "Novak") in view of Florin et al. (U.S. Patent No. 5,621,456; hereinafter "Florin"), further in view of Lupulescu.

Applicant respectfully submits that the rejection of the aforementioned claims under 35 U.S.C. § 103 is defective for the reason that prior art references when combined do not teach or suggest all of the claim limitations of the independent claims of the present application. In order to expedite prosecution, Applicant has amended the claims to further clarify Applicant's claimed invention.

Applicable Law

In rejecting claims under 35 U.S.C. § 103, the Examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. See M.P.E.P. § 2142. The courts hold that the *Graham* factual inquiries are to be used to evaluate claims for obviousness, instructing as follows:

"Under § 103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the

pertinent art resolved. Against this background the obviousness or nonobviousness of the subject matter is determined.”¹

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art.”² All words in a claim must be considered in judging the patentability of that claim against the prior art.”³ Office personnel must rely on the Applicant’s disclosure to properly determine the meaning of the claims.”⁴

Finally, the recent U.S. Supreme Court decision of *KSR v. Teleflex* provides a tripartite test to evaluate obviousness. “A rationale to support a conclusion that a claim would have been obvious is that ***all the claimed elements were known*** in the prior art and one skilled in the art could have combined the elements as claimed by known methods ***with no change in their respective functions***, and that ***the combination would have yielded nothing more than predictable results*** to one of ordinary skill in the art.”⁵ Emphasis added.

Applicant respectfully submits that the applied references do not satisfy the Graham inquiries, as they fail to include each element claimed; and further, Applicant disagrees with the Examiner’s characterization of the applied references as teaching the claimed inventive subject matter.

¹ 127 S.Ct. 1727, 82 USPQ2d 1385 (2007). 383 U.S. 1, 17, 86 S.Ct. 684, 15 L.Ed.2d 545 (1966). The Court in *KSR v. Teleflex*, at page 1730, quoted the analysis of *Graham* from page 18.

² *In re Royka* 490 F.2d 981, 180 USPQ 580 (CCPA 1974).

³ *In re Wilson* 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

⁴ *Markman v. Westview Instruments* 52 F.3d 967, 980, 34 USPQ2d 1321, 1330 (Fed. Cir.) (*en banc*), *aff’d*, U.S., 116 S. Ct. 1384 (1996).

⁵ *KSR International Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 82 U.S.P.Q.2d 1385 (2007).

Claims 1-6

Applicant respectfully submits that the applied references do not satisfy the Graham inquiries, as they fail to include each element claimed; and further, Applicant disagrees with the Examiner's characterization of the applied references as teaching the claimed inventive subject matter. Applicant's amended claim 1 recites:

1. A system for effecting a transaction, including a head-end,
a communications network,
a subscriber secure device,
a receiver, capable of
receiving digital information, including content data from the head-end through the network, and of making the content data available to a user on a display device, which receiver further includes an interface to the subscriber secure device, wherein the receiver is programmed to make a first code available on the display device, the first code uniquely identifying the subscriber secure device, and wherein no return channel is available from the head-end to the receiver,
a transaction server,
a client secure device, and
a terminal being communicatively linked to the transaction server, wherein the terminal comprises a user interface for entering the first code, wherein the terminal is arranged to create a transaction token from the entered first code in co-operation with the client secure device, and wherein the terminal is arranged to transmit the transaction token to the transaction server for ordering a product independently of transmission of the product from the head-end to the receiver.

Applicant respectfully disagrees with the Examiner's characterization of Novak as teaching a "receiver" as recited in Applicant's claim 1. Specifically, the Examiner has identified the Set Top Box (STB) 102 of Novak's FIG. 1 as the "receiver," and agrees that there is no teaching in Novak of the STB 102 being "programmed to make a first code available on the display device." Applicant further submits that Novak does not teach a "first code uniquely identifying a subscriber secure device."

The Examiner further characterizes Florin as teaching a system to make a first code available on the display device. The Examiner identifies the confirmation display field 425 of Florin's FIG. 41⁶ as a "first code." Applicant respectfully disagrees, as the confirmation display

⁶ Florin, p. 22, ll. 33-41.

field 425 of Florin is used to enter a Personal Identification Number (PIN), which identifies a subscriber, but which is not a “first code uniquely identifying a subscriber device.”

The applied references further fail to disclose “a terminal being communicatively linked to the transaction server, wherein the terminal comprises a user interface for entering the first code, wherein the terminal includes an interface to the client secure device, wherein the terminal is arranged to create a transaction token from the entered first code in cooperation with the client secure device, and wherein the terminal is arranged to transmit the transaction token to the transaction server for ordering a product independently of transmission of the product from the head-end to the receiver,” in a system wherein “no return channel is available from the receiver to the head-end.”

In Novak and Florin, a return channel is available and used for interaction with the head-end (see e.g., Novak, FIG. 1 and paragraph 52 and Florin, FIG. 1 and col. 8, lines 19-24). Thus, the problem of not being able to order products due to not having a return channel does not exist in Novak and Florin.

Therefore, one of ordinary skill in the art would not consult Lupulescu to find a solution for such problem, as the problem simply does not exist. The Examiner relies on Lupulescu as disclosing elements of Applicant’s claims; however, Lupulescu does not disclose a “client secure device” or a “terminal” wherein the terminal “is arranged to create a transaction token from the entered first code” or wherein the terminal “is arranged to transmit the transaction token to the transaction server for ordering a product independently of the transmission of the product from the head-end to the receiver,” as recited in Applicant’s amended claim 1.

The system of Lupulescu is a web based method for ordering television programming from a cell phone. Lupulescu specifically states:

“[t]he user first accesses the m-PPV system by entering the website URL containing the PPV information database on his or her cellular phone or PDA display screen, via step 57. The database contains television event schedules and user records of previous user purchases.”⁷

The cell phone of Lupulescu does not satisfy the limitations of a “terminal” or a “client secure device,” as recited in Applicant’s claim 1, but rather is a means for accessing a server, where the

⁷ Lupulescu, ¶35.

user first logs in, and then accesses menu information.⁸ The cell phone of Lupulescu is not arranged to create a transaction token.

Further, Lupulescu does not teach a terminal to “create the transaction token from the entered first code in co-operation with the client secure device” as recited in Applicant’s claim 1. While Lupulescu teaches entry of information to a website, there is no teaching of a transaction token, or creation of a transaction token using a first code in co-operation with the client secure device. In Lupulescu, the cell phone is merely an access point to the server, and does not *co-operate* in creating a token.

Additionally, Applicant’s amended claim 1 recites a “first code uniquely identifying a subscriber secure device.” While Lupulescu teaches a user ID and password as a first code, there is no teaching or suggestion of a “first code uniquely identifying a subscriber secure device.” According to the Examiner’s characterization of the reference, the subscriber secure device is the “subscriber’s television system,”⁹ however, there is no teaching or suggestion of a code uniquely identifying a subscriber secure device. In the Pay-Per-View (PPV) model of Lupulescu, the user ID and password allow access to a user account; there is no teaching of a code identifying a subscriber secure device or the use of such a code to create a transaction token.

Applicant further respectfully submits that Lupulescu teaches away from Applicant’s claimed invention, rather than teaching a system to make “the content data available to a user on a display device ... wherein the receiver is programmed to make a first code available on the display device,” which enables the user to read the first code and then enter the first code in the terminal. In fact, Lupulescu teaches a “system and method [that] allows a subscriber, when away from home, to purchase PPV events for the subscriber’s television system” (see e.g., Lupulescu, Abstract). Thus, the subscriber is not able to read the first code from the display device of the receiver in order to subsequently enter the first code in the terminal. With the system and method of Lupulescu, no first code would thus be made available on the display device of the receiver.

⁸ Ibid. ¶36.

⁹ Office Action, dated April 21, 2009, pp. 2-3.

Applicant has amended claims 2-4 consistently with the amendments to claim 1.

Therefore, for at least the reasons presented with respect to claim 1, the applied references do not alone or in combination teach or suggest all of the claim limitations of the pending claims of the present application. Applicant respectfully submits that the applied references fail to teach the elements and limitations of the pending claims and respectfully requests reconsideration and allowance of the pending claims.

Reservation of Rights

In the interest of clarity and brevity, Applicant may not have equally addressed every assertion made in the Office Action, however, this does not constitute any admission or acquiescence. Applicant reserves all rights not exercised in connection with this response, such as the right to challenge or rebut any tacit or explicit characterization of any reference or of any of the present claims, the right to challenge or rebut any asserted factual or legal basis of any of the rejections, the right to swear behind any cited reference such as provided under 37 C.F.R. § 1.131 or otherwise, or the right to assert co-ownership of any cited reference. Applicant does not admit that any of the cited references or any other references of record are relevant to the present claims, or that they constitute prior art. To the extent that any rejection or assertion is based upon the Examiner's personal knowledge, rather than any objective evidence of record as manifested by a cited prior art reference, Applicant timely objects to such reliance on Official Notice, and reserves all rights to request that the Examiner provide a reference or affidavit in support of such assertion, as required by MPEP § 2144.03. Applicant reserves all rights to pursue any cancelled claims in a subsequent patent application claiming the benefit of priority of the present patent application, and to request rejoinder of any withdrawn claim, as required by MPEP § 821.04.

CONCLUSION

Applicant respectfully submits that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's representative at (206) 420-2534 to facilitate prosecution of this application.

If necessary, please charge any additional fees or deficiencies, or credit any overpayments to Deposit Account No. 19-0743.

Respectfully submitted,

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By

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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being filed using the USPTO's electronic filing system EFS-Web, and is addressed to: Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 21st day of July, 2009.

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Signature